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HEWLETT PACKARD COMPANY  
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INTELLECTUAL PROPERTY ADMINISTRATION  
FORT COLLINS, CO 80527-2400

EXAMINER
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STOREY, WILLIAM C

ART UNIT	PAPER NUMBER
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2625

NOTIFICATION DATE	DELIVERY MODE
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02/20/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

**Application No.**

10/700,215

**Applicant(s)**

SEVIER, RICHARD G.

**Examiner**

WILLIAM C. STOREY

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4-10,20,23-29,39 and 50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-10,20,23-29,39 and 50 is/are rejected.
- 7) ☒ Claim(s) 1 & 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/ are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities: The interlineation proposed in the applicant's response contains an error. For [0041.1], "106 that he first digital" should be "106 that the first digital."

Appropriate correction is required.

### ***Claim Objections***

2. Claims 1 & 20 are objected to because of the following informalities: "Objects and, sending the first set of digital images" should be "objects, and sending the first set of digital images." Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 5-8, 20, 25-27, 39, & 50 are rejected under 35 U.S.C. 102(e) as being anticipated by Okubo (US Patent Application Publication 2005/0200903).

Regarding claim 1, Okubo discloses a digital image selection method, comprising: obtaining a first digital image of a first side of a physical object; the physical

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object is a first of an ordered set of physical objects; examining the first digital image to determine if it is substantially blank; if the first digital image is not substantially blank, obtaining a first set of digital images, each digital image of the first set being a digital image of a first side of a physical object of the ordered set of physical objects and, sending the first set of digital images for processing; and if the first digital image is substantially blank, obtaining a second set of digital images, each digital image of the second set being a digital image of a second side of a physical object of the ordered set of physical objects, and sending the second set of digital images for processing. In addition, Okubo discloses an image-processing device. Further, Okubo discloses that an "image-processing unit 12 converts the analog RGB read signals received from the image reading unit 11 into digital image data of continuous-tone or multi-value (multi-valued image data), for example color image data (or gray image data). The image-processing unit 12 sends the multi-valued image data to the binarizing unit 13 and the optimizing unit 15," as disclosed at paragraph 23. Okubo discloses that the system may read images from a double-sided original, as disclosed at paragraph 22. This reads on claimed "obtaining a first digital image of a first side of a physical object" as well as obtaining a second digital image of a second side of the physical object. In addition, Okubo discloses the "optimizing unit 15 eliminates pages judged as blank pages from the image data received directly from the image processing unit 12, on the basis of the determination for each page of the image data received from the determining unit 14," as disclosed at Figure 1 and paragraph 35. This reads on claimed "examining the first digital image to determine if it is substantially blank." Further, Okubo discloses "the

optimizing unit 15 optimizes the image data and sends the optimized image data to the compressing unit 16 and data output unit," as disclosed at Figure 1 and paragraph 35. In addition, Okubo discloses "the determining unit 14 determines on a page-by-page basis whether or not data is image data," which reads on claimed if the "if the digital image of the first set is not substantially blank" and "if the first digital image is substantially blank," as disclosed in paragraph 27. If the "set" is a set of 1, then this and the previous disclosures read on "sending the second digital image for processing if the first digital image is substantially blank; and sending the first digital image for processing if the first digital image is not substantially blank." For example, if the front side of a piece of paper (set) is blank, the opposite side of the set of 1 is sent. If the front side isn't blank, the front side of the set of 1 will be sent.

Regarding claim 5, Okubo discloses everything as applied above for claim 1. In addition, Okubo discloses discarding the first digital image if it is substantially blank. Further, Okubo discloses the optimizing unit 15 eliminates pages which were judged as blank pages by the determining unit 14 from the image data received directly from the image processing unit 12, which reads on claimed the method of claim 1, further comprising discarding the first digital image if it is substantially blank, as disclosed at paragraph 28.

Regarding claim 6, Okubo discloses everything claimed as applied above in claim 1. In addition, Okubo discloses wherein the steps of obtaining the first and second sets of digital images comprise: scanning the first side of each physical object in the ordered set to generate the first set of digital images; and scanning the second side

of each physical object in the ordered set to generate the second set of digital images. Okubo discloses in paragraph 22 an image reading unit 11 comprising a well-known CCD or the like, which optically reads an image from a double-sided or single-sided original. "Optically reads" reads on claimed scanning. Sides of a double-sided original read on first side of each physical object and second side of each physical object. In addition, Okubo discloses an "image-processing unit 12 converts the analog RGB read signals received from the image reading unit 11 into digital image data of continuous-tone or multi-value (multi-valued image data)" disclosed at paragraph 23. Digital image data reads on claimed digital images.

Regarding claim 7, Okubo discloses everything as applied above for claim 1. In addition, Okubo discloses sending the second set of digital images for processing comprises sending the second set of digital images to be printed if the first digital image is substantially blank; and sending the first set of digital images for processing comprises sending the first set of digital images to be printed if the first digital image is not substantially blank. Specifically, Okubo discloses that the data output unit 17 may send the image data to an external device such as a printer, which, in combination with the disclosure referenced in support of the rejection of claim 1, reads on claimed the method of claim 1, wherein: sending the second set of digital images for processing comprises sending the second set of digital images to be printed if the first digital image is substantially blank; and sending the first set of digital images for processing comprises sending the first set of digital images to be printed if the first digital image is

not substantially blank, as disclosed at paragraph 30. Disclosed printer reads on claimed "printed."

Regarding claim 8, Okubo discloses everything as applied above for claim 1. In addition, Okubo discloses sending the second set of digital images for processing comprises sending the second set of digital images to be incorporated in a facsimile transmission if the first digital image is substantially blank; and sending the first set of digital images for processing comprises sending the first set of digital images to be incorporated in a facsimile transmission if the first set of digital images is not substantially blank. Specifically, Okubo discloses that the data output unit 17 may send the image data to an external device such as a facsimile, which, in combination with the disclosure referenced in support of the rejection of claim 1, reads on claimed the method of claim 1, wherein: sending the second set of digital images for processing comprises sending the second set of digital images to be incorporated in a facsimile transmission if the first digital image is substantially blank; and sending the first set of digital images for processing comprises sending the first set of digital images to be incorporated in a facsimile transmission if the first set of digital images is not substantially blank, as disclosed at paragraph 30. Disclosed facsimile reads on claimed incorporated in a facsimile transmission.

Regarding claim 20, Okubo discloses everything claimed as applied above (see claim 1). In addition, claim 20 discloses a computer readable medium having instructions for: obtaining a first digital image of a first side of a physical object; the physical object is a first of an ordered set of physical objects; examining the first digital

image to determine if it is substantially blank; if the first digital image is not substantially blank, obtaining a first set of digital images, each digital image of the first set being a digital image of a first side of a physical object of the ordered set of physical objects and, sending the first set of digital images for processing; and if the first digital image is substantially blank, obtaining a second set of digital images, each digital image of the second set being a digital image of a second side of a physical object of the ordered set of physical objects, and sending the second set of digital images for processing. However, this is not patently distinct from the method described in claim 1, thus claim 20 is rejected for the same reasons as stated above in the rejection of claim 1.

Regarding claim 25, Okubo discloses everything claimed as applied above (see claim 6). In addition, claim 25 discloses the medium of claim 20, wherein the instructions for obtaining the first and second sets of digital images include instructions for: scanning the first side of each physical object in the ordered set to generate the first set of digital images; and scanning the second side of each physical object to generate the second set of digital images. However, this is not patently distinct from the method described in claim 6, thus claim 25 is rejected for the same reasons as stated above in the rejection of claim 6.

Regarding claim 26, Okubo discloses everything claimed as applied above (see claim 7). In addition, claim 26 discloses the medium of claim 20, wherein the instructions for: sending the second set of digital images for processing include instructions for sending the second set of digital images to be printed if the first digital image is substantially blank; and sending the first set of digital images for processing

include instructions for sending the first set of digital images to be printed if the first digital image is not substantially blank. However, this is not patently distinct from the method described in claim 7, thus claim 26 is rejected for the same reasons as stated above in the rejection of claim 7.

Regarding claim 27, Okubo discloses everything claimed as applied above (see claim 8). In addition, claim 27 discloses the medium of claim 20, wherein the instructions for: sending the second set of digital images for processing include instructions for sending the second set of digital images to be incorporated in a facsimile transmission if the first digital image is substantially blank; and sending the first set of digital images for processing include instructions for sending the first set of digital images to be incorporated in a facsimile transmission if the first digital image is not substantially blank. However, this is not patently distinct from the method described in claim 8, thus claim 27 is rejected for the same reasons as stated above in the rejection of claim 8.

Regarding claim 39, Okubo discloses everything claimed as applied above (see claim 1). In addition, claim 39 discloses a system for digital image selection, comprising: an image manager operable to obtain a first digital image of a first side of a physical object and a second digital image of a second side of the physical object; a content module operable to examine the first digital image to determine if it is substantially blank; and wherein the image manager is further operable to send the second digital image for processing if the first digital image is substantially blank and to send the first digital image for processing if the first digital image is not substantially

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blank; wherein the physical object is a first of an ordered set of physical objects and wherein the image manager is further operable to: if the first digital image is not substantially blank, obtain a first set of digital images, each digital image of the first set being a digital image of a first side of a physical object of the ordered set of physical objects, and send the first set of digital images for processing; and if the first digital image is substantially blank, obtain a second set of digital images, each digital image of the second set being a digital image of a second side of a physical object of the ordered set of physical objects, and send the second set of digital images for processing.

However, the system simply provides structure for the method of claim 1 and is not patently distinct; thus, claim 39 is rejected for the same reasons as stated above in the rejection of claim 1. Specifically, Okubo discloses an image reading unit, image processing unit, binarizing unit, determining unit, optimizing unit, and compressing unit, and data output unit which read on claimed image manager, as disclosed in figure 1. Further, Okubo discloses a determining unit and an optimizing unit, which read on claimed content module, as disclosed in figure 1.

Regarding claim 50, Okubo discloses everything as applied for claim 1. Image reading unit 11, image processing unit 12, and binarizing unit 12 are equivalent to means for obtaining a first digital image of a first side of a physical object and a second digital image of a second side of the physical object or first or second sets of digital images. The image-reading unit obtains the image of the sides of a physical object, as disclosed in paragraph 22. The image processing unit and binarizing unit read on converting the obtained data into a digital image, as disclosed at paragraph 23 and 24.

Determining unit 14 is equivalent to means for examining the first digital image to determine if it is substantially blank, as disclosed at paragraph 27. Data output unit 17 is equivalent to means for sending the second set of digital images for processing if the first digital image is substantially blank and means for sending the first set of digital images for processing if the first digital image is not substantially blank, as disclosed in paragraph 30. The external device disclosed in paragraph 30 is a means for processing.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4 & 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okubo as applied in claim 1 and/or 20 in view of Furumura (Japanese Publication 05-048835).

Regarding claim 4, Okubo discloses everything claimed as applied above in claim 1. However, Okubo fails to disclose wherein the step of examining is performed before the step of obtaining the second set of digital images and the step of obtaining the second set of digital images is performed only if the first digital image is substantially blank. In addition, the examiner maintains that it was well known in the art to provide the step of examining performed before the step of obtaining the second set of digital images and

the step of obtaining the second set of digital images is performed only if the first digital image is substantially blank, as taught by Furumura.

In a similar field of endeavor, Furumura discloses the step of examining performed before the step of obtaining the second set of digital images and the step of obtaining the second set of digital images is performed only if the first digital image is substantially blank. In addition, Furumura discloses an image reader. Further, Furumura describes scanning one side of a piece of paper; checking whether or not it was blank after it has been scanned; if it is, the end of the paper is pinched and sent back through to scan the other side, as disclosed in paragraph 12.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Okubo by specifically providing the step of examining performed before the step of obtaining the second set of digital images and the step of obtaining the second set of digital images is performed only if the first digital image is substantially blank, as taught by Furumura, for the purpose of preventing blank paper information from being read by erroneous insertion of the paper surface into the input of the image reading device, as disclosed in the abstract.

Regarding claim 23, Okubo discloses everything claimed as applied above (see claim 4). In addition, claim 23 discloses the medium of claim 20, wherein the instructions obtaining the second set of digital images include instructions for obtaining the second set of digital images only if the first digital image is substantially blank. However, this is not patently distinct from the method described in claim 4, thus claim 23 is rejected for the same reasons as stated above in the rejection of claim 4.

Regarding claim 24, Okubo discloses everything claimed as applied above (see claim 5). In addition, claim 24 discloses the medium of claim 20, having further instructions for discarding the first digital image if it is substantially blank. However, this is not patently distinct from the method described in claim 5, thus claim 24 is rejected for the same reasons as stated above in the rejection of claim 5.

7. Claims 9 & 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okubo as applied in claim 1 and/or 20 in view of Garcia (US Publication Application Publication 2003/0048470).

Regarding claim 9, Okubo discloses everything claimed as applied above in claim 1. In addition, Okubo discloses that the data output unit 17 may send the image data to an external device such as a personal computer, as disclosed in paragraph 30. However, Okubo fails to describe incorporation of the image file on the computer into an electronic mail message. In addition, the examiner maintains that it was well known in the art to provide incorporation of an image file into an electronic mail message, as taught by Garcia.

In a similar field of endeavor, Garcia discloses incorporating an image file into an electronic mail message. In addition, Garcia discloses a web browser for network printer. Further, Garcia describes scanning documents to create a digital image of a document and an email function that permits electronic mailing of the digital image, as disclosed in paragraph 29.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Okubo by specifically providing incorporation of

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an image file into an electronic mail message, as taught by Garcia, for the purpose of acting as an another method of data output, as is well known in the art.

Regarding claim 28, Okubo discloses everything claimed as applied above (see claim 9). In addition, claim 28 discloses the medium of claim 20, wherein the instructions for: sending the second set of digital images for processing include instructions for sending the second set of digital images to be incorporated in an electronic mail message if the first digital image is substantially blank; and sending the first set of digital images for processing include instructions for sending the first set of digital images to be incorporated in an electronic mail message if the first set of digital images is not substantially blank. However, this is not patently distinct from the method described in claim 9, thus claim 28 is rejected for the same reasons as stated above in the rejection of claim 9.

8. Claims 10 & 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okubo as applied in claim 1 and/or 20 in view of Nakano (US Patent Application Publication 2004/0145770).

Regarding claim 10, Okubo discloses everything claimed as applied above in claim 1. In addition, Okubo discloses that the data output unit 17 may send the image data to an external device such as a personal computer, as disclosed in paragraph 30. However, Okubo fails to describe archival of the image file. In addition, the examiner maintains that it was well known in the art to provide archival of an image file, as taught by Nakano.

In a similar field of endeavor, Nakano discloses archiving of digital images. In addition, Nakano discloses managing digital images. Further, Nakano discloses copying or moving a digital image to an archive directory on a desktop computer, server, or removable medium, as disclosed in paragraph 25.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Okubo by specifically providing archiving of digital images, as taught by Nakano, for the purpose of allowing better management of digital images, as disclosed in paragraph 4.

Regarding claim 29, Okubo discloses everything claimed as applied above (see claim 10). In addition, claim 29 discloses the medium of claim 20, wherein the instructions for: sending the second set of digital images for processing include instructions for sending the second set of digital images to be archived if the first digital image is substantially blank; and sending the first set of digital images for processing include instructions for sending the first set of digital images to be archived if the first digital image is not substantially blank. However, this is not patently distinct from the method described in claim 10, thus claim 29 is rejected for the same reasons as stated above in the rejection of claim 10.

### ***Response to Arguments***

9. Applicant's arguments filed 12/19/2007 have been fully considered but they are not persuasive. The applicant states: "Okubo mentions nothing of first obtaining digital images for a selected first of second sides of a set of pages where the particular side is selected based upon whether or not the first [side] of an initial page is substantially

blank. Consequently, Okubo fails to teach the third and fourth limitations of Claim 1 listed above." The invention of Okubo performs reading of a double-sided original, which is well known to those of ordinary skill in the art to construe reading of images on the front and back of an original (see ¶ 22). The claimed invention refers to a first and second set of images, each image being of a first or second side of a physical object (here represented by the original). As disclosed above, if the scenario is a set of 1, then the set would consist of a single original (which, of course, may be double-sided). In compliance with, and uncontested by the applicant, the 1st and 2nd limitations of claim 1 are read upon by Okubo. Okubo discloses reading the original to obtain digital image data and determining and eliminating blank pages from that digital image data set (see ¶ 23, 35, and figure 1). Then, the non-blank pages are sent out of the set of 1 for further processing and data output (¶ 35, figure 1). The applicant claims: "if the first digital image is not substantially blank, obtaining a first set of digital images, each digital image of the first set being a digital image of a first side of a physical object of the ordered set of physical objects, and sending the first set of digital images for processing." This process has been discussed above. However, for elucidation, the examiner points out that: if the first digital image is not substantially blank, the first digital is not thrown out for being blank. It follows the process as described above. The applicant also claims: "if the first digital image is substantially blank, obtaining a second set of digital images, each digital image of the second set being a digital image of a second side of a physical object of the ordered set of physical objects, and sending the second set of digital images for processing." This process has been discussed above.

However, for elucidation, the examiner points out that: if the first digital image is substantially blank, the first digital is thrown out for being blank. The double-sided reading will also obtain the "second side," and send the substance of the second side through the process. It follows the process as described above.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

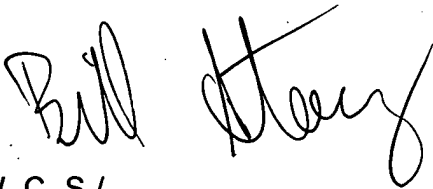
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM C. STOREY whose telephone number is (571)270-3576. The examiner can normally be reached on Monday - Friday Eastern Standard Time.

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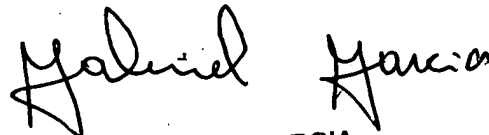
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



W. C. S./  
Examiner, Art Unit 2625

William C Storey  
Examiner  
Art Unit 2625



GABRIEL GARCIA  
PRIMARY EXAMINER